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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,994	08/21/2003	Heinz Willebrand	81598 (7293)	1124
22242	7590	02/25/2005	EXAMINER	
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			PHAN, HANH	
			ART UNIT	PAPER NUMBER
			2633	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,994

Applicant(s)

WILLEBRAND ET AL.

Examiner

Hanh Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/16/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 11/24/2004.

Specification

2. The amendment filed 11/24/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

-The Amendment filed on 11/24/2004 added new figures 10 and 11 and three new paragraphs to the specification to show and describe the feature "**an optical reflector**" which does not disclosed in the specification and shown in the drawings. Therefore, the Amendment introduces new matter into the disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-4, 7-17, 19-22 and 24-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

-In claims 2, 8 and 19, the feature "the controller is configured as a binary switch" which does not disclosed in the specification as filed.

-In claims 3, 4, 7, 9, 20 and 21, the feature "the controller is configured to receive environmental information, and wherein the portions of the data to be transmitted through the laser portion and the radio frequency portion are adjusted by the controller based on the environmental information" which does not disclosed in the specification as filed.

-In claims 10, 12, 14 and 22, the feature "wherein the laser portion and the radio frequency portion have transmit and receive strengths, and wherein the controller is configured to monitor the transmit and receive strengths, wherein the portions of the data to be transmitted through the laser portion and the radio frequency portion are adjusted by the controller based on their transmit and receive strengths" which does not disclosed in the specification as filed.

-In claim 11, the feature "wherein the controller includes a plurality of latches and a logic device, wherein the plurality of latches and the logic device operate to provide adjustment levels for the portions of the data to be transmitted through the laser portion and the radio frequency portion" which does not disclosed in the specification as filed.

-In claims 15 and 24, the feature "wherein the at least one laser portion and the the at least one radio frequency portion are configured to transmit and

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receive in tandem, whereby the node may be configured to provide a hybrid serial link to permit tailored radio frequency or optical network connections" which does not disclosed in the specification as filed.

-In claim 17, the feature "an optical reflector" which does not disclosed in the specification as filed.

-In claims 25 and 27, the feature "wherein at least a portion of the network is configured as ring topology" which does not disclosed in the specification as filed.

-In claims 26 and 28, the feature "wherein at least a portion of the network is configured as SONET ring" which does not disclosed in the specification as filed.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 5, 6, 18 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S.

Patent No. 6,763,195 (Willebrand et al). Although the conflicting claims are not

identical, they are not patentably distinct from each other because the limitations recited in claims 1, 5, 6, 18 and 23 of the instant application are encompassed by claims 1-38 of U.S. Patent No. 6,763,195 (Willebrand et al).

Regarding claims 1 and 18, Willebrand et al (U.S. Patent No. 6,763,195) discloses a node incorporating hybrid radio frequency and optical wireless communication links, the node comprising:

- at least one laser portion for transmitting data;
- at least one radio frequency portion for transmitting data;
- a data receiver for receiving data from a data source; and
- a controller configured to receive data from a data source and connected with the laser portion and the radio frequency portion to allocate portions of the data to be transmitted through the laser portion and the radio frequency portion (see claims 1 and 3-8 of U.S. Patent No. 6,763,195).

Regarding claim 5, Willebrand et al (U.S. Patent No. 6,763,195) discloses the laser portion is configured to both transmit and receive and wherein the radio frequency portion is configured to both transmit and receive (see claims 1 and 3-8 of U.S. Patent No. 6,763,195).

Regarding claims 6 and 23, Willebrand et al (U.S. Patent No. 6,763,195) discloses the laser portion and the radio frequency portion are configured to transmit in multiple channels (see claims 1 and 3-8 of U.S. Patent No. 6,763,195).

7. Claims 1, 5, 6, 18 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of copending Application No. 10/840,172 (Willebrand et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in claims 1, 5, 6, 18 and 23 of the instant application are encompassed by claims 1-45 of copending Application No. 10/840,172 (Willebrand et al).

Regarding claims 1 and 18, Willebrand et al (copending Application No. 10/840,172) discloses a node incorporating hybrid radio frequency and optical wireless communication links, the node comprising:

- at least one laser portion for transmitting data;
- at least one radio frequency portion for transmitting data;
- a data receiver for receiving data from a data source; and
- a controller configured to receive data from a data source and connected with the laser portion and the radio frequency portion to allocate portions of the data to be transmitted through the laser portion and the radio frequency portion (see claims 1-7 and 15-24 of copending Application No. 10/840,172).

Regarding claim 5, Willebrand et al discloses the laser portion is configured to both transmit and receive and wherein the radio frequency portion is configured to both transmit and receive (see claims 1-7 and 15-24 of copending Application No. 10/840,172).

Regarding claims 6 and 23, Willebrand et al discloses the laser portion and the radio frequency portion are configured to transmit in multiple channels (see claims 1-7 and 15-24 of copending Application No. 10/840,172).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 5, 6, 18 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 (re-numbered) of copending Application No. 09/835,866 (Willebrand). Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in claims 1, 5, 6, 18 and 23 of the instant application are encompassed by claims 1-7 of copending Application No. 09/835866 (Willebrand).

Regarding claims 1 and 18, Willebrand (copending Application No. 09/835,866) discloses a node incorporating hybrid radio frequency and optical wireless communication links, the node comprising:

- at least one laser portion for transmitting data;

- at least one radio frequency portion for transmitting data;

- a data receiver for receiving data from a data source; and

- a controller configured to receive data from a data source and connected with the laser portion and the radio frequency portion to allocate portions of the data to be transmitted through the laser portion and the radio frequency portion (see claims 1-7 and 15-24 of copending Application No. 09/835,866).

Regarding claim 5, Willebrand discloses the laser portion is configured to both transmit and receive and wherein the radio frequency portion is configured to both transmit and receive (see claims 1-7 of copending Application No. 09/835,866).

Regarding claims 6 and 23, Willebrand discloses the laser portion and the radio frequency portion are configured to transmit in multiple channels (see claims 1-7 of copending Application No. 09/835,866).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 5, 6, 8, 18, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vollert (Pub. No. DE 4433896 C1 cited by applicant) in view of Mullaly et al (US Patent No. 6,812,881).

Regarding claims 1 and 18, referring to Figure 1, Vollert discloses a node incorporating hybrid radio frequency and optical wireless communication links, the node comprising:

at least one infrared portion for transmitting data (i.e., infrared portion for transmitting data IUS, Fig. 1);

at least one radio frequency portion for transmitting data (i.e., radio frequency portion for transmitting data FUS, Fig. 1);

a data receiver (Fig. 1) for receiving data from a data source; and

a controller (Fig. 1) configured to receive data from a data source and connected with the infrared portion and the radio frequency portion to allocate portions of the data to be transmitted through the infrared portion and the radio frequency portion (see abstract section).

Vollert differs from claims 1 and 18 in that he fails to teach the optical portion for transmitting data is a laser portion for transmitting data. However, Mullaly in US Patent No. 6,812,881 teaches the optical portion for transmitting data is a laser portion for transmitting data (Fig. 2b, col. 9, lines 17-33). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to incorporate the optical portion for transmitting data is a laser portion for transmitting data as taught by Mullaly in the system of Vollert. One of ordinary skill in the art would have been motivated to do this since Mullaly suggests in column 9, lines 17-33 that using such the optical portion for transmitting data is a laser portion for transmitting data have advantage of allowing providing a light source for transmitting data with narrow spectral width, coherent, and highly directional.

Regarding claims 2, 8 and 19, the combination of Vollert and Mullaly teaches the controller is configured as a binary switch such that the data is transmitted exclusively through either one of the laser portion and the radio frequency portion (Fig. 1 of Vollert and Fig. 2b of Mullaly).

Regarding claim 5, the combination of Vollert and Mullaly teaches the laser portion is configured to both transmit and receive and wherein the radio frequency portion is configured to both transmit and receive (Fig. 1 of Vollert and Fig. 2b of Mullaly).

Regarding claims 6 and 23, the combination of Vollert and Mullaly teaches the laser portion and the radio frequency portion are configured to transmit in multiple channels (Fig. 1 of Vollert and Fig. 2b of Mullaly).

11. Claims 1, 2, 5, 6, 8, 18, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US Patent No. 4,904,993 cited by applicant) in view of Mullaly et al (US Patent No. 6,812,881).

Regarding claims 1 and 18, referring to Figure 1, Sato discloses a node incorporating hybrid radio frequency and optical wireless communication links, the node comprising:

- at least one optical portion for transmitting data (i.e., optical transmitter 14 and 13, Fig. 1);

- at least one radio frequency portion for transmitting data (i.e., RF transmitter 12 and 11, Fig. 1);

- a data receiver (i.e., data supply 15 and data generator 16, Fig. 1) for receiving data from a data source; and

- a controller (i.e., switches 17 and 18, Fig. 1) configured to receive data from a data source and connected with the infrared portion and the radio frequency portion to

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allocate portions of the data to be transmitted through the infrared portion and the radio frequency portion (col. 2, lines 25-47 lines 51-67 and col. 3, lines 1-3).

Sato differs from claims 1 and 18 in that he fails to teach the optical portion for transmitting data is a laser portion for transmitting data. However, Mullaly in US Patent No. 6,812,881 teaches the optical portion for transmitting data is a laser portion for transmitting data (Fig. 2b, col. 9, lines 17-33). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to incorporate the optical portion for transmitting data is a laser portion for transmitting data as taught by Mullaly in the system of Sato. One of ordinary skill in the art would have been motivated to do this since Mullaly suggests in column 9, lines 17-33 that using such the optical portion for transmitting data is a laser portion for transmitting data have advantage of allowing providing a light source for transmitting data with narrow spectral width, coherent, and highly directional.

Regarding claims 2, 8 and 19, the combination of Sato and Mullaly teaches the controller is configured as a binary switch such that the data is transmitted exclusively through either one of the laser portion and the radio frequency portion (Fig. 1 of Sato and Fig. 2b of Mullaly).

Regarding claim 5, the combination of Sato and Mullaly teaches the laser portion is configured to both transmit and receive and wherein the radio frequency portion is configured to both transmit and receive (Fig. 1 of Sato and Fig. 2b of Mullaly).

Regarding claims 6 and 23, the combination of Sato and Mullaly teaches the laser portion and the radio frequency portion are configured to transmit in multiple channels (Fig. 1 of Sato and Fig. 2b of Mullaly).

12. Claims 1, 2, 5, 6, 8, 18, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zavrel (US Patent No. 5,585,953) in view of Mullaly et al (US Patent No. 6,812,881).

Regarding claims 1 and 18, referring to Figure 1, Zavrel discloses a node incorporating hybrid radio frequency and optical wireless communication links, the node comprising:

at least one infrared portion for transmitting data (i.e., IR transmitter 24, Fig. 1);

at least one radio frequency portion for transmitting data (i.e., RF transmitter 12, Fig. 1);

a data receiver (i.e., data controller 16, Fig. 2) for receiving data from a data source; and

a controller (i.e., switches 20 and 22, Fig. 1) configured to receive data from a data source and connected with the infrared portion and the radio frequency portion to allocate portions of the data to be transmitted through the infrared portion and the radio frequency portion (col. 1, lines 62-67 and col. 2, lines 1-11).

Zavrel differs from claims 1 and 18 in that he fails to teach the optical portion for transmitting data is a laser portion for transmitting data. However, Mullaly in US Patent No. 6,812,881 teaches the optical portion for transmitting data is a laser portion for

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transmitting data (Fig. 2b, col. 9, lines 17-33). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to incorporate the optical portion for transmitting data is a laser portion for transmitting data as taught by Mullaly in the system of Zarel. One of ordinary skill in the art would have been motivated to do this since Mullaly suggests in column 9, lines 17-33 that using such the optical portion for transmitting data is a laser portion for transmitting data have advantage of allowing providing a light source for transmitting data with narrow spectral width, coherent, and highly directional.

Regarding claims 2, 8 and 19, the combination of Zarel and Mullaly teaches the controller is configured as a binary switch such that the data is transmitted exclusively through either one of the laser portion and the radio frequency portion (Fig. 1 of Zarel and Fig. 2b of Mullaly).

Regarding claim 5, the combination of Zarel and Mullaly teaches the laser portion is configured to both transmit and receive and wherein the radio frequency portion is configured to both transmit and receive (Fig. 1 of Zarel and Fig. 2b of Mullaly).

Regarding claims 6 and 23, the combination of Zarel and Mullaly teaches the laser portion and the radio frequency portion are configured to transmit in multiple channels (Fig. 1 of Zarel and Fig. 2b of Mullaly).

13. Claims 1, 2, 5, 6, 8, 18, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petsko (US Patent No. 5,999,294) in view of Mullaly et al (US Patent No. 6,812,881).

Regarding claims 1 and 18, referring to Figures 1-4, Petsko discloses a node incorporating hybrid radio frequency and optical wireless communication links, the node comprising:

- at least one infrared portion for transmitting data (i.e., infrared portion for transmitting data 182, Fig. 4);

- at least one radio frequency portion for transmitting data (i.e., radio frequency portion for transmitting data 324, Fig. 4);

- a data receiver (Fig. 4) for receiving data from a data source; and

- a controller (Fig. 4) configured to receive data from a data source and connected with the infrared portion and the radio frequency portion to allocate portions of the data to be transmitted through the infrared portion and the radio frequency portion (col. 4, lines 35-52, col. 5, lines 5-32 and col. 6, lines 46-57).

Petsko differs from claims 1 and 18 in that he fails to teach the optical portion for transmitting data is a laser portion for transmitting data. However, Mullaly in US Patent No. 6,812,881 teaches the optical portion for transmitting data is a laser portion for transmitting data (Fig. 2b, col. 9, lines 17-33). Therefore, it would have been obvious to one having skill in the art at the time the invention was made to incorporate the optical portion for transmitting data is a laser portion for transmitting data as taught by Mullaly in the system of Petsko. One of ordinary skill in the art would have been motivated to do this since Mullaly suggests in column 9, lines 17-33 that using such the optical portion for transmitting data is a laser portion for transmitting data have advantage of allowing

providing a light source for transmitting data with narrow spectral width, coherent, and highly directional.

Regarding claims 2, 8 and 19, the combination of Petsko and Mullaly teaches the controller is configured as a binary switch such that the data is transmitted exclusively through either one of the laser portion and the radio frequency portion (Fig. 4 of Petsko and Fig. 2b of Mullaly).

Regarding claim 5, the combination of Petsko and Mullaly teaches the laser portion is configured to both transmit and receive and wherein the radio frequency portion is configured to both transmit and receive (Fig. 4 of Petsko and Fig. 2b of Mullaly).

Regarding claims 6 and 23, the combination of Petsko and Mullaly teaches the laser portion and the radio frequency portion are configured to transmit in multiple channels (Fig. 4 of Petsko and Fig. 2b of Mullaly).

Response to Arguments

14. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh Phan whose telephone number is (571)272-3035.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached on (571)272-3022. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.


HANH PHAN
PRIMARY EXAMINER